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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,620	01/09/2002	Jason C. Gilmore	47079-0129	4385
30223	7590	04/12/2006	EXAMINER	
<b>JENKENS &amp; GILCHRIST, P.C.</b> 225 WEST WASHINGTON SUITE 2600 CHICAGO, IL 60606				MOSSER, ROBERT E
		ART UNIT		PAPER NUMBER
		3712		

DATE MAILED: 04/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/042,620	GILMORE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Robert Mosser	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 June 2005.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1, 3-11, 13-31 is/are rejected.
- 7) Claim(s) 2 and 12 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 January 2002 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

**DETAILED ACTION**

♦  
*In response to the amendment and arguments dated June 16<sup>th</sup>, 2005.*

♦  
**Claims 1-31 are pending.**

♦  
***Claim Objections***

Claims 2 and 12 are objected to because of the following informalities: The claims as presented refer to a plurality of selectable elements initially masks the corresponding -one of a plurality of respective outcome- juxtaposed to -one of a plurality of respective outcomes-. The indicated omission of a concluding "s" to outcome is understood as a typo given the use of the plural outcomes throughout the claims. Appropriate correction is required.

***Terminal Disclaimer***

The Terminal Disclaimer submitted June 16<sup>th</sup>, 2005 has been received and was approved.

***Drawings***

Corrected drawings were received and entered on June 16<sup>th</sup>, 2005.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 3-9, 11, and 13-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Moody et al (US 5,976,016).

Regarding at least claims 1, 3, 8, 11, 13 and 18. Moody et al discloses a multi-line slot machine method including the receiving of wagers from players, displaying to the player on a first row of the slot machine a plurality of symbols, allowing the player to select which of the symbols to hold, and generating random replacement symbols for the symbols not held, and awarding a prize to the player according to the symbols and the pay table (Figures 1-3 & Col 1:33-48). Thus, in response to a wager the player selects the symbols to hold and the award is determined by the combination of these selected and adjacent non-selected symbols along the pay line providing the respective reward outcomes in accordance with the pay table. This correlates to at least the displaying of a plurality of selectable elements, each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes, wherein the Selectable element is the symbol hold indicator for each respective column of elements and the Respective outcomes are represented with the initial game selection of symbols shown in figure 1.

Regarding at least claims **4** and **14**, Moody et al teaches the payout dependent on multiple combinations with associated payouts or an award payoff as so described (Col 4:10-24).

Regarding at least claims **5**, **7**, **15**, and **17**, Moody et al teaches the awarding a bonus round or a bonus game as so described resultant of a special combination being obtained in the method described previously (Col 6:16-28).

Regarding at least claims **6** and **16**, Moody et al teaches the use of traditional mechanical slot wheels that are stacked vertically and are rotated vertically before being stopped in vertical association with the display area (Col 6:49-64).

Regarding at least claims **9** and **19**, Moody et al teaches the display of a plurality of selectable elements in a matrix including a plurality of rows and columns and wherein at least one of the non-elected elements for which the outcome is awarded includes a plurality of the non-selected elements adjacent to the selected element (Figures 1-3).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

- (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Moody et al (US 5,976,016) as applied to claims 1 and 11 above, and further in view of Schneider et al (US 6,089,976).

Moody et al is silent as to the use of an animated pattern encompassing the selected element in response to the selection. Schneider et al teaches the use of an animated pattern for the purpose of removing all of the elements that have not been selected and the elements that have been selected but do not form a pair (Figures 2-5 & Col 4:47-63). It would have been obvious for one of ordinary skill in the art at the time of invention to have utilized the animated pattern of Schneider et al in the invention of Moody et al in order to emphasize the winning combinations and play lines that contain these combinations.

Claims 21-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneider et al (US 6,089,976).

Regarding at least claims **21** and **26**, Schneider et al teaches a method for a game of chance on a gaming machine including receiving a wager from a player (Col 4:29-40), conducting a primary game based on the random reel outcome, starting a secondary game based on random tile placement responsive to a start-secondary game outcome in the primary game, and starting a primary game response to a start-primary game outcome in the secondary game (Figure 7). The start outcomes are understood as the qualifying outcome and the outcome of matching two rewards in the secondary game of Schneider. Schneider however teaches his secondary game and primary game in an opposite configuration. It would have been obvious to one of ordinary skill in the art at the time of invention to have interchanged the primary game and secondary game of Schneider in order create a game with a guaranteed percentage wager return and a chance at a jackpot prize. The game mechanics of the primary and secondary game of Schneider are not the same mechanics. Schneider teaches a game outcome allowing the player to play a primary game subsequent to playing the secondary game however is silent regarding doing so without requiring a wager (Figure 7). It would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to win (qualify for) a free primary game in the secondary game in similar manner as taught by Schneider for qualifying in a primary game for the secondary, in order maintain a player's interest in utilizing the device as taught by Schneider (Col 1:44-46).

Regarding at least claims **22**, **23**, **27**, and **28**, Schneider et al teaches his previously secondary game as including interactive selection wherein the player selects

an element and receives the award associated with the selection of an element prior to selecting at least one more element (Col 2:65-3:16 & Figures 2-4). As stated above the previously primary game of Schneider et al is understood as the secondary game of the applicant while the previously secondary game of Schneider et al is understood as the primary game of the applicant.

Regarding at least claims 24, 25, and 31, and in addition to the above stated in the rejection of claims 21-23 and 26-28. Schneider et al teaches the use of a slot reel game including a plurality of symbol bearing slot reels that are rotated and stopped to place symbols on the reels in visual association with a display area in his previously primary game (Col 5:9-33 & Figure 1).

Regarding at least claims 29 and 30. Schneider et al teaches the step of conducting a primary slot game including awarding a payout based on the symbols displayed in the display area of a video display (Col 5:20-33 & Col 2:57-64).

### ***Response to Arguments***

Applicant's arguments filed June 16<sup>th</sup>, 2005 and with regards to claims 1, 2-11, and 13-31 have been fully considered but they are not persuasive.

Issues surround the Double patenting rejection and Drawings are addressed above and so will not be repeated herein.

The applicant's arguments dated August 23<sup>rd</sup>, 2004 have been previously considered and persist in not supporting a substitutive separation between the applicants claimed invention and the prior art as applied.

On page 9 of the remarks by applicant submitted June 16<sup>th</sup>, 2005 the Applicant states, "The Applicants respectfully request the Examiner to then consider the substantial difference between the Applicants' invention and Moody's symbol-replacement feature that occurs on Moody's pay lines."

In the clarification of this argument the Examiner considers only the claimed invention in view of the specification but does not limit the claims by the specification in accordance with [MPEP 2105].

[From MPEP 2105]

It is only when the specification provides definitions for terms appearing in the claims that the specification can be used in interpreting claim language. In re Vogel, 422 F.2d 438, 441, 164 USPQ 619, 622 (CCPA 1970). See also Superguide Corp. v. DirecTV Enterprises, Inc., 358 F.3d 870, 875, 69 USPQ2d 1865, 1868 (Fed. Cir. 2004)

The court ruled that limitations, not present in the claims, were improperly imported from the specification. See also In re Marosi, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) ("Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation." 710 F.2d at 802, 218 USPQ at 292 (quoting In re Okuzawa, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original)).

In correlation the Applicant presents "Claims 1 and 11 require "displaying a plurality of selectable elements, each one of the plurality of selectable elements being associated with a corresponding one of a plurality of respective outcomes." (Emphasis added) As such, there is a direct, one-to-one relationship between each selectable element and its corresponding outcome.", on page 9 of the remarks by Applicant submitted June 16<sup>th</sup>, 2005.

The Applicant is arguing the claims of a narrower scope than presented. Specifically the relevant independent claims each include the term "comprising". The

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term "comprising" reduces the strength of the later presented limitations so as to allow not just the argued and later presented one-to-one correspondence to exist (Applicant's claim language "...with a corresponding one...") but additionally an interpretation wherein the plurality of selectable elements are each associated with multiple corresponding ones of a plurality of respective outcomes. In other words the presented correlation is directed to the association of multiple outcomes to each selected symbol with multiple outcomes must by definition comprise multiple "corresponding one's" of respective outcomes and therefore address the limitation as presented. Though the Applicant cites multiple references from within their applications specification to support the narrower limitation their claims, none of these reference effect the interpretation of claim language as presented or in view of MPEP 2105 as presented above.

The Applicant Continues on Page 10 of the Remarks submitted June 16<sup>th</sup>, 2005 to argue "awarding to the player the outcomes associated with the selected element and the at least one of the non-selected elements", and arguments associated therewith, that the awarding of an outcome as claimed must included implicitly or otherwise the feature of delivering a physically tangible good to the player. Such a narrow construction of the claim however is improper as the outcomes of Moody are paid for by the player through a wager, presented to the player on the display and resultant thereof used to determine a payout if any due to the player. Hence awarding does not necessitate a physical transfer or presentation of goods so long as there is mutually (between the game and player in this case) understood transfer of rights associated or connected with those goods. In this instance the right of transfer is

specifically the right to any prize resultant of a winning prize combination formed by the elements awarded to the player.

On Page 11 of the Remarks submitted June 16<sup>th</sup>, 2005, the Applicant argues the interpretation of the prior art outcomes. This feature has been clarified in the remarks above.

The Applicant Continues on Page 10 of the Remarks submitted June 16<sup>th</sup>, 2005 to argue against the inclusion of a matrix of selectable elements comprising a plurality of rows and columns in the prior art of Moody. Moody teaches allowing the player to designate symbols along plurality columns to hold as well as designate a plurality of rows for which to play and hence for which the player designations will carry forth and hence defines the matrix as applied in the rejection above. The Applicant would appear to be considering their plurality of selectable elements, as equivalent to a plurality of individually selectable elements not supported by the claims. And while not yet presented by Applicant the claimed "receiving from the player of one of the plurality of selectable elements" (Claim 1) would not exclude the player selection of multiple elements from the plurality of elements under the claimed term "comprising" in similar light to the preceding discussion of this section.

Applicant's amendments to claims 2 and 12 have provided sufficient separation between the claimed invention and the prior art.

On page 12 of the Remarks submitted June 16<sup>th</sup>, 2005, the Applicant states "In doing so, the Examiner does not address any of the newly added claim amendments that were included in the RCE.", with regards to the rejections under USC 103 in view of

Schneider. Applicant additionally argues that the amendments submitted with the filing of the RCE on 10/28/2004 were focused on "substantial" differences and yet were addressed by the examiner with essentially ("with the exception of the last few sentences" Page 12 of the applicant's remarks cited above) the same rejection as previously presented under USC102 presented prior to the filing of the RCE only transformed to a rejection under USC 103.

The Applicant strongly and out right states that the Examiner has not considered their claims limitations, on Page 13 of their remarks provides an alleged example directed to a start primary game outcome present in the secondary game. This feature has been previously addressed in the rejection of the Non-final office action dated March 11th, 2005 on page 8 as "In addition it would have been obvious to one of ordinary skill in the at the time of invention to have incorporated the ability to win a / qualify for a free primary game in the secondary game in similar manner as taught by Schneider for qualifying in a primary game for the secondary, in order maintain a player's interest in utilizing the device.", while Schneider has been previously cited in the same action for teaching "...starting a secondary game response to a start-secondary game outcome in the primary game,...". Hence as presented in the previous rejections and repeated herein, the Examiner has set forth the *prima facie* case of obviousness regarding the cited claims as well as the particular limitations to which the Applicant Argues.

In response to Applicant's statement that they "strongly object...". The examiner notes that the features of a "first" and "second" bonus game where clearly and distinctly addressed in the rejection of the claims based upon the prior art. In using the term "seems" in response to applicant's prior arguments the examiner was merely attempting

to further explain these correlations and further explain the interpretation of the claims used in making the rejections. The examiner apologizes for any ambiguity caused by choosing this terminology and believes the respective rejection of record clearly and distinctly show the correlations being made.

The Applicant proposes that the claim construction is improper for ignoring commonly accepted terminology used in wager-game events with respect to a primary and a secondary gaming event. The terminology in question only specifies the tiers of a multi-tier game and in accordance therewith the rejection of record re-associates the respective games with the respective tiers. Hence the Applicant appears to be arguing semantics and the incorporation of a primary and a secondary game are maintained in the rejection as presented and correlated above.

Finally the Applicant challenges the redress of presented claim language "without requiring an additional wager" in the previous office action. In reply the office action states "In addition it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the ability to win (qualify for) a free primary game in the secondary game in similar manner as taught by Schneider for qualifying in a primary game for the secondary, in order maintain a player's interest in utilizing the device." Allowing the player to acquire a free primary game in a bonus game wherein the primary game initially required a wager to initiate (Figure 7 Schneider) provides for the presented claim limitation as previously presented, however the language of the rejection has clarified for the Applicant.

***Allowable Subject Matter***

Claims **2** and **12** are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims **2** and **12** are noted as being subject to the additional Examiner's objection presented above.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Mosser whose telephone number is (571)-272-4451. The examiner can normally be reached on 8:30-4:30 Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan M. Thai can be reached on (571) 272-7147. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

REM



SCOTT JONES  
PRIMARY